

DETAILED ACTION

1. This Office action is in response to the initial filing on 08/28/2003. The priority benefits under 35 U.S.C. 119 have been considered. Claims 1-29 are currently pending and are considered below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-6, 8-21 are rejected under 35 U.S.C 103(a) as being unpatentable over Obata et al (US Patent Application No. 2003/0065580) ("Obata"), and in view of Kamakura et al (US Patent No. 6,076,101) ("Kamakura").

4. Regarding claim 1, Obata discloses: A method of operating a marketing scheme comprising the steps of:

(a) registering a participant at the marketing activity; [0040]; [0041]; [0042];
[0065]

(b) providing specific commercial information by a first participant to a further participant; [0012]; [0020]; [0048]; [0049]; [0053]; [0087]

Obata lacks explicit recital of

- (c) receiving a response to said transmissible element from a second party who is one of said plurality of receiving parties;
 - (d) accumulating the number of responses received from said plurality of receiving parties;
 - (e) comparing said accumulated number of responses with a target total; and
 - (f) delivering a first prize to said second party when said accumulated number of received responses equals the target total.
5. However, Kamakura implicitly shows
- (c) replying to a received message (col. 3, ll. 40-46; col. 3, ll. 60-63; col. 4, ll. 22-26; col. 5, ll. 1-4; col. 7, ll. 1-7)
 - (d) comparing the accumulated number with a target threshold (fig. 10, elem. S53; col. 9, ll. 28-32)
 - (e) delivering a notification on the reward made possible by hitting the target (fig. 10, elem. S54; col. 9, ll. 33-36)

Regarding the accumulating of responses, Kamakura discloses analyzing each received message (col. 3, ll. 43-48; col. 4, ll. 26-31; col. 5, ll. 5-7; col. 7, ll. 41-65). Specifically, Kamakura teaches assigning points to each response (col. 3, ll. 43-48) and determining a reward based on the accumulated number of responses (figure 9). Therefore, Kamakura necessarily teaches accumulating the number of responses, at least when there is a 1-1 correspondence between responses and points (e.g. 1 point per response).

6. It would have been obvious to a person of ordinary skill in the art at the time of the invention to complement Obata's teachings with Kamakura's, which modifies and complements the process with critical steps. Modification and complementation of the Obata process would have provided "... an electronic mail processing system that encourages the recipients to open, read, and reply to the e-mail message from the sender." (col. 1, ll. 58-60)

7. Regarding claim 3, the combination of references discloses: The method of operating the marketing scheme according to Claim 1 (see claim 1 rejection above) wherein a party is provided with commercial information to be communicated to a user. (see Obata [0012]; [0020]; [0048]; [0049]; [0053]; [0087])

8. Regarding claim 5, the combination of references discloses: The method of operating the marketing scheme according to Claim 1 (see claim 1 rejection above) wherein a seller is registered with the promotion support system. (see Obata [0010]; [0065])

9. Regarding claim 6, the combination of references discloses: The method of operating the marketing scheme according to Claim 5 (see claim 5 rejection above) wherein said seller provides an incentive (i.e. prize). (see Obata [0014])

10. Regarding claim 8, the combination of references discloses: The method of operating the marketing scheme according to Claim 5 (see claim 5 rejection above) wherein user is shown the incentive (i.e. prize). (see Kamakura fig. 6, elem. 11-12; col. 3, ll. 33-36; col. 6, ll. 55-58)

11. Regarding claim 9, the combination of references discloses: The method of operating the marketing scheme according to Claim 8 (see claim 8 rejection above) wherein said user is permitted to select a prize. (see Kamakura col. 9, ll. 33-36)

12. Regarding claim 10, the combination of references discloses: The method of operating the marketing scheme according to Claim 8 (see claim 8 rejection above) wherein said first party is permitted to register to acquire said transmissible element. (see Obata fig. 1, elem. 12; [0021]; [0040]; [0041]; [0042])

13. Regarding claim 11, the combination of references discloses: The method of operating the marketing scheme according to Claim 5 (see claim 5 rejection above) wherein a registration form is customized to meet the requirements of said seller. (see Obata [0041])

14. Regarding claim 12, the combination of references discloses: The method of operating the marketing scheme according to Claim 11 (see claim 11 rejection above)

wherein said user must complete said registration form before the transaction begins.

(see Obata [0016])

15. Regarding claim 13, the combination of references discloses: The method of operating the marketing scheme according to Claim 12 (see claim 12 rejection above) wherein the information is sent to said first party in an email further including instructions on how to retransmit the information. (see Obata [0048]; [0049])

16. Regarding claim 14, the combination of references discloses: The method of operating the marketing scheme according to Claim 13 (see claim 13 rejection above) wherein user must transmit information in order to win a prize. (see Obata [0014])

17. Regarding claim 15, the combination of references discloses: The method of operating the marketing scheme according to Claim 1 (see claim 1 rejection above) whereupon receipt of information, said receiving party is advised of their chance to win said prize and is invited to respond to the received information. (see Kamakura col. 5, l 49 through col. 6, l 11)

18. Regarding claim 16, the combination of references discloses: The method of operating the marketing scheme according to Claim 15 (see claim 15 rejection above) whereupon responding to information, the information is communicated to a new user (i.e. third user) in subsequent proceedings. (see Obata [0020]; [0087])

19. Regarding claim 17, the combination of references discloses: The method of operating the marketing scheme according to Claim 5 (see claim 5 rejection above) wherein when user does not win a prize, user has to register with the seller in order to obtain the information. (see Obata fig. 1, elem. 12; [0021]; [0040]; [0041]; [0042])

20. Regarding claim 18, the combination of references discloses: The method of operating the marketing scheme according to Claim 17 (see claim 17 rejection above) whereupon receiving the information, user is advised on communicating it to other parties. (see Obata [0048]; [0049])

21. Regarding claim 19, the combination of references discloses: The method of operating the marketing scheme according to Claim 17 (see claim 17 rejection above) wherein user must transmit information to another user in order to win a second prize. (see Obata [0012]; [0020]; [0048]; [0049]; [0053]; [0087])

22. Regarding claim 20, the combination of references discloses: The method of operating the marketing scheme according to Claim 19 (see claim 19 rejection above) wherein when user responds to information, the information is communicated to a new user (i.e. third user) in subsequent proceedings. (see Obata [0020]; [0087])

23. Regarding claim 21, the combination of references discloses: The method of operating the marketing scheme according to Claim 20 (see claim 20 rejection above) wherein when accumulated number of received responses matches said target total, the user will become subject to a verification of the validity of the responses. (see Kamakura col. 6, ll. 33-43)

24. Claims 2, 4, 7 and 23 are rejected under 35 U.S.C 103(a) as being unpatentable over Obata et al (US Patent Application No. 2003/0065580) ("Obata"), in view of Kamakura et al (US Patent No. 6,076,101) ("Kamakura"), and in further view of Canada NewsWire (article titled: Panasonic Power Thursday a Huge Success) ("Canada").

25. Regarding claim 2, the combination of references discloses: The method of operating the marketing scheme according to Claim 1 (see claim 1 rejection above). The combination of references does not explicitly disclose wherein a second prize is also delivered to a third party from whom said second party received said transmissible element. However, Canada teaches providing a prize to another user who has been informed about the possibility (paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of references with the teaching of Canada in order to produce more prize winners and, therefore, to increase the number of potential users.

26. Regarding claim 4, the combination of references discloses: The method of operating the marketing scheme according to Claim 2 (see claim 2 rejection above). The combination of references does not explicitly disclose wherein said target total is established in accordance with the value and number of said first and second prizes. However Canada teaches a target total based on the value of the prizes (paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of references with the teaching of Canada in order to keep the expenses for prizes under control.

27. Regarding claim 7, the combination of references discloses: The method of operating the marketing scheme according to Claim 5 (see claim 5 rejection above). The combination of references does not explicitly disclose wherein said fourth party determines said target total. However, Canada teaches a total set by the seller (paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of references with the teaching of Canada for the seller is the one who provides the prize money and he has to keep expenses within limits.

28. Regarding claim 23, the combination of references discloses: The method of operating the marketing scheme according to Claim 10 (see claim 10 rejection above). The combination of references does not explicitly disclose wherein said registration of said first party is added to said accumulated number of received responses and when

said first prize is delivered to said first party without the delivery of a second prize to said second party, the at least one remaining prize is used in a periodic random draw amongst all the registered parties. However, Canada teaches, in addition to the prizes delivered according to the rules, a random draw for a "lucky" user (paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of references with the teaching of Canada in order to attract more potential users.

29. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obata et al (US Patent Application No. 2003/0065580) ("Obata"), in view of Kamakura et al (US Patent No. 6,076,101) ("Kamakura"), and in further view of Markel (US Patent Publication No. 2002/0133817) ("Markel").

30. Regarding claim 22, the combination of references discloses: The method of operating the marketing scheme according to Claim 1 (see claim 1 rejection above). The combination of references does not explicitly disclose wherein when said first prize is won, registrants for said first prize are informed of the fact with a request that no further transmission are made in respect of said first prize and no further registrations therefore are accepted. However Markel teaches stopping the counting once the set threshold is reached ([0030]; claim 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of

references with the teaching of Markel for the seller is the one who provides the prize money and prize distribution has to stop once the prize budget has been exhausted.

31. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obata et al (US Patent Application No. 2003/0065580) ("Obata"), in view of Kamakura et al (US Patent No. 6,076,101) ("Kamakura"), and in further view of Tanigawa (US Patent Publication No. 2003/0074255) ("Tanigawa").

32. Regarding claim 24, the combination of references discloses: The method of operating the marketing scheme according to Claim 1 (see claim 1 rejection above). The combination of references does not explicitly disclose wherein said transmissible element is selected from the group consisting of HTML and textual messages. However, Tanigawa teaches using simple text and hyperlinks in HTML form [0045]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of references with the teaching of Tanigawa in order to increase the feedback possibilities of the user who receives the message with information.

33. Regarding claim 25, the combination of references discloses: The method of operating the marketing scheme according to Claim 24 (see claim 24 rejection above) wherein information further comprises instructions as to how it should be used to win a prize. (see Kamakura col. 3, ll. 33-43; col. 3, ll. 57-63)

34. Regarding claim 26, the combination of references discloses: The method of operating the marketing scheme according to Claim 24 (see claim 24 rejection above). The combination of references does not explicitly disclose wherein said transmissible element comprises responding means chosen from the group consisting of a hyperlink and an email address to a recording centre. However, Tanigawa teaches using simple text and hyperlinks in HTML form [0045]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the combination of references with the teaching of Tanigawa in order to increase the feedback possibilities of the user who receives the message with information.

35. Regarding claim 27, the combination of references discloses: The method of operating the marketing scheme according to Claim 24 (see claim 24 rejection above) wherein a seller is registered with the promotion support system and information is customized in accordance with seller requirements. (see Obata [0010]; [0041]; [0065])

36. Claims 28 and 29 are rejected under 35 U.S.C 103(a) as being unpatentable over Obata et al (US Patent Application No. 2003/0065580) ("Obata").

37. Regarding claim 28, Obata discloses: A system for implementing a marketing scheme comprising a plurality of data bases storing all required information (elements

12, 14, 17, 18 and 20 in figures 1, 6 and 8), as well as a plurality of software programs (elements 21 and 20 in figures 1, 6 and 8).

38. Claim 28 recites a "wherein" clause with nonfunctional descriptive material. However, it has been held that when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). (see MPEP 2106.01)

39. Regarding claim 29, Obata discloses: A system for implementing a marketing scheme according to Claim 28 (see claim 28 rejection above) wherein said system further comprises a plurality of software programs (elements 21 and 20 in figures 1, 6 and 8).

40. Claim 29 recites a "wherein" clause with nonfunctional descriptive material. However, it has been held that when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C.

102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). (see MPEP 2106.01)

CONCLUSIONS

41. The prior art of record and not relied upon in this Office action, but considered to be relevant to Applicant's disclosure:

- Stewart D.L.; "Sliding Headfirst Into Geezerdom"; Dayton Daily News, Dayton OH, Jul 27, 2001, page 1C – teaches delivering a prize after a predetermined number of responses have been received
- US 20010047294 A1; System and method for adding an advertisement to a personal communication; Rothschild, Anthony R.
- US 20010025253 A1; Multi-level award program; Heintz, Christopher J. et al.
- US 20010044745 A1; Method of providing and tracking embedded e-mail advertising; Shaw, Mark D.
- US 20020174011 A1; Systems and methods for conducting a loyalty program; Sanchez, Michael F. et al.
- US 20030195807 A1; Method and system for verifying exposure to message content via a printed response; Maggio, Frank S. et al.

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42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RADU ANDREI whose telephone number is (571)270-5283. The examiner can normally be reached on Mo-Thurs 8am-5pm.

43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on 571.272.6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

44. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RADU ANDREI/
Examiner, Art Unit 4137

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 4137